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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,404	09/07/2006	Antoni Torrens Jover	284362US0PCT	3482
22850	7590	09/21/2010		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MCDOWELL, BRIAN E	
			ART UNIT 1624	PAPER NUMBER
			NOTIFICATION DATE 09/21/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/566,404	<b>Applicant(s)</b> TORRENS JOVER ET AL.	
	<b>Examiner</b> BRIAN MCDOWELL	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 7/26/2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18,20-56,58-61 and 64-75 is/are pending in the application.
- 4a) Of the above claim(s) 15-17,20-41,58-60,64-66,68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13,18,42-56,61,67,69-73 is/are rejected.
- 7) ☒ Claim(s) 14,74 and 75 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-18, 20-56 ,58-61 and 64-75 are pending in the instant application. Claim 75 is new. Claims 15-17, 20-41, 58-60, 64-66, and 68 are withdrawn from consideration. Claims 1-14, 18, 42-56, 61, 67, and 69-75 are under examination.

### ***Previous Objections/Rejections***

*Any rejections or objections stated of record in the office action mailed on 1/25/2010 that are not explicitly addressed herein below, are hereby withdrawn in light of applicant's arguments and/or amendments filed 7/26/2010.*

### ***Duty of Disclosure***

Applicants are reminded of their duty to disclose all pertinent information regarding patentability of the instant claims (see MPEP 2001.06). The examiner respectfully requests that applicants provide the sources of the proviso compounds listed in claim 1.

***Status of Rejections***

***35 USC § 112 (2<sup>nd</sup> Paragraph)***

**The rejection of claims 1-13, 18, 42-56, 61, 67, and 69-73 is maintained.**

Applicant's arguments, see Remarks, filed 7/26/2010, with respect to the rejection set forth in the Non-Final Office Action mailed 1/25/2010, have been fully considered but are not found persuasive.

Applicant suggests that the limitation described in the instant claims wherein substituent "R<sup>10</sup>" may be condensed further with "mono- or polycyclic ring systems" or "aryl- or heteroaryl ring systems" is not ambiguous and can readily be interpreted by the skilled artisan. The examiner respectfully disagrees.

The above language encompasses overlapping Markush members and have been found indefinite by the courts. See *Ex parte White*, 127 USPQ 261. "The double inclusion of an element in a claim has long been held to be objectionable since it makes the claims vague and indefinite and fails to point out and distinctly claim the invention as required by 35 U.S.C. Section 112."

Also see *Simmons Company v. A. Brandwein & Co. et al.* 111 USPQ 171 (affirmed at 115 USPQ 307): "Double inclusion of an element in a claim is objectionable because it makes the claim vague, indefinite and lacks the 'particularly pointing out and distinctly claiming' required by the statute." Again, this is an explicit statement that double inclusion renders the claim indefinite. The same language appears in *Endevco Corporation v. Chicago Dynamic Industries, Inc.*, 153 USPQ 231.

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Thus, the claims are considered indefinite. Again, applicant is advised to remove overlapping Markush members within the instant claims to obviate this rejection.

**35 USC § 103**

**The rejection of claims 1, 42-45, 47-55, 61, 72, and 73 is maintained.**

Applicant's amendments, see Remarks, filed 7/26/2010, with respect to the rejection set forth in the Non-Final Office Action mailed 1/25/2010, have been fully considered but are not found persuasive.

The instant claims may still encompass a homologous analogue (wherein the substituted cycloaliphatic radical is bonded via an *ethylene* group) when compared to the prior art compound described by Bock which would render the claims obvious.

### ***New Objections and Rejections***

#### ***Claim Objections***

The preamble of claim 1 and other generic claims should simply read "A compound of formula (I)" since the chemical structures fully describe the class of compounds being claimed. Correction is required.

#### ***Claim Rejections - 35 USC § 112 (2<sup>nd</sup> Paragraph)***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the aforementioned claim 1, the limitation

"and whereby said cycloaliphatic radical may be bonded via an optionally at least mono-substituted alkylene group,"

is considered indefinite since there is insufficient antecedent basis for this limitation in the claim.

#### ***Conclusion***

Claims 1-13, 18, 42-56, 61, 67, and 69-73 are rejected.

Claims 14, 74, and 75 are objected to as being dependent upon a rejected base claim, but would *potentially* be allowable if rewritten in independent form including all of the

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limitations of the base claim and any intervening claims. The species embraced within the claims appear free of the prior art and are novel with respect to substituent "W".

This application contains claims drawn to an invention nonelected with traverse in the reply filed on 7/26/2010. **A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN MCDOWELL whose telephone number is (571)270-5755. The examiner can normally be reached on Monday-Thursday 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRIAN MCDOWELL/  
Patent Examiner, Art Unit 1624

**/James O. Wilson/  
Supervisory Patent Examiner, AU 1624**